

## REMARKS

This Amendment & Response amends claims 1, 25 and 26, cancels no claims, and adds no new claims. Claims 1-26 remain pending in the application.

### ***Objections/Rejections Under 35 U.S.C. §102 and §103***

**1.0** *The Examiner has rejected claims 1-12, 14-19 and 21-26 as anticipated by Del Castillo (United States Patent 6,742,188).*

### SUMMARY OF CITED REFERENCE

**Del Castillo** (United States Patent No. 6,742,188) discloses a method and system for encoding addressable control data into the horizontal overscan area of a video signal for controlling operation of a controlled device associated with the encoded address. The control data is concatenated with the video signal, thereby permitting the controlled device, such as a wireless mechanical character, to behave as characters in a scene defined by the programming information of the video signal.

### SUMMARY OF CLAIMED INVENTION

The Present Claimed Invention is a device, system and method for selectively providing human perceptible indicia in synchronization with a video program.

The device includes (i) a communications port to receive a video input signal of a video program, (ii) a central processing unit for detecting control data embedded in a received video input signal, (iii) an interface device for allowing user input of selection criteria; and (iv) selectively activated indicia. The central processing unit is programmed to selectively activate the indicia upon receipt of control data based upon the input selection criteria.

The system includes (i) means for embedding data into a broadcast signal of the video program, (ii) means for transmitting the broadcast signal and embedded data, (iii) means for receiving the broadcast signal and embedded data, (iv) means for inputting selection criteria, and (v) an external device configured and arranged to selectively provide the indicia upon receipt of the embedded data based upon input selection criteria.

The method includes the steps of (i) embedding data in the broadcast signal of a video program, (ii) transmitting the broadcast signal, (iii) receiving the broadcast signal at a remote location, (iv) detecting the data embedded in the broadcast signal, and (v) selectively activating the indicia in response to the data embedded in the broadcast signal based upon user input selection criteria.

#### LEGAL BASIS

An anticipation rejection under 35 U.S.C. § 102 requires that the cited reference(s) disclose each and every element of the claimed invention. *See, Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Kloster Speedsteel AB et al. v. Crucible Inc. et al.*, 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986). A reference anticipates a claim only when the reference discloses each and every element recited in the claim. *See, Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) and M.P.E.P. §2131. Accordingly, the “exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference.” *Atlas Powder Co. v. E.I. duPont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

#### *DEL CASTILLO DOES NOT DISCLOSE EACH AND EVERY ELEMENT OF THE CLAIMED INVENTION*

Del Castillo discloses a method and system for addressed based control of a device in concatenation with programming presented by a video signal using control data embedded within the video signal. Del Castillo does NOT disclose, teach or suggest that such control can or should be selective, based upon selection criteria input by a user.

By way of nonlimiting example, Del Castillo discloses a method and system wherein separate and distinct controlled devices (*i.e.*, a first controlled device bearing the Minnesota Vikings logo and a second controlled device bearing the Green Bay Packers logo) are individually signaled to scream "TOUCHDOWN" by addressed control data embedded within the television signal for a football game between the Vikings and the Packers whenever the corresponding team scores a touchdown. In contrast, the Present Claimed Invention is directed to a device, system and method wherein a single controlled device (*i.e.*, a controlled device bearing the likeness of sports announcer John Madden) is signaled by control data embedded within the same television signal showing the game between the Vikings and the Packers to scream "TOUCHDOWN" whenever a team - any team - scores a touchdown, but the controlled device only screams "TOUCHDOWN" when the Minnesota Vikings are the team scoring the touchdown because the user of the device is a Vikings fan and the user has input selection criteria into the device instructing the device to activate only when Minnesota scores a touchdown.

Withdrawal of this rejection is respectfully requested.

**2.0**    *The Examiner has rejected claims 13 and 20 as obvious over Del Castillo (United States Patent 6,742,188).*

#### LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

As to the first criteria, it is necessary to ascertain whether or not the reference motivates one of ordinary skill in the relevant art, having the reference before him, to make the proposed substitution, combination, or modification. In re Linter, 458 F.2d 1013, 173 U.S.P.Q. 560, 562 (CCPA 1972). Obviousness can only be established where there is some teaching, suggestion or motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art, to combine the references and produce the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q. 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *See*, M.P.E.P. § 2143.01.

*DEL CASTILLO DOES NOT DISCLOSE EACH AND EVERY  
ELEMENT OF THE CLAIMED INVENTION*

As stated above, in connection with the rejection of claims 1-12, 14-19 and 21-26 as anticipated by Del Castillo, Del Castillo discloses a method and system for addressed based control of a device in concatenation with programming presented by a video signal using control data embedded within the video signal. Del Castillo does NOT disclose, teach or suggest that such control can or should be selective, based upon selection criteria input by a user.

Withdrawal of this rejection is respectfully requested.

## CONCLUSION

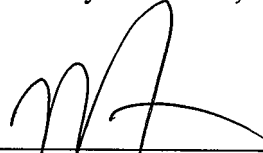
Applicant respectfully submits that all pending claims (claims 1-26) are in condition for allowance.

Respectfully submitted,

Date

13 Feb 2007

By



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